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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,631	04/14/2005	Anne Costantini	37261P108	8391
8791 7590 02/04/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
MILLER, WILLIAM L				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/531,631

**Applicant(s)**

COSTANTINI, ANNE

**Examiner**

William L. Miller

**Art Unit**

3677

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection on 11-11-2008. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's previously unentered amendment filed on 08-07-2008 has now been entered. Claims 1-15 and 17-31 are pending.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 10, 12-15, 20, 23-27, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurmond (US#5347262). *Please reference annotated Fig. 1 of Thurmond provided on page 3 of the previous Office action which provides pictorial analysis of the claimed elements of the invention and is necessary to meet any claim limitations not addressed in detail below.*
5. Regarding claims 1, 13, and 23, Thurmond discloses an electronic button tag comprising a transponder (68) that is capable of being programmed, (see Summary of the Invention - lines 20-30), enclosed in a shell, said shell comprising an open-ended or blind axial transverse passage

(61) for a fixing means (10), wherein the shell is made from two half shells namely a lower half shell (or first shell portion) and an upper half shell (or second shell portion), which are capable of being assembled together at a median plane which is disposed transversely to the axial passage opening for the fixing means, and the transponder is enclosed within the two half-shells and enclosed without compression between the two half-shells. (See annotated Fig. 1 of Thurmond).

6. Further regarding claim 1 and the amended preamble, specifically the relabeling of the electronic button tag as an “animal tagging and identification electronic button tag”, the applicant is reminded where there is physical identity between the subject matter of the claims and the prior art, the label given to the claimed subject matter does not distinguish the invention over the prior art. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Lemin, 326 F.2d 437, 140 USPQ 273 (CCPA 1964). Moreover, since Thurmond discloses all of the claimed structure of the applicant’s tag, then the tag can be viewed and labeled as “animal tagging and identification electronic button tag”. The added limitation of “arranged to uniquely identify an animal in a group of animals” represents the intended use of the invention. If the Thurmond button was attached to an animal, it would be capable of uniquely identifying that animal in a group of animals, upon disassembly of the tag.

7. Further, regarding claim 23, the applicant is reminded method limitations, such as laser welding, are given little patentable weight in an article claim as the patentability of a product does not depend on its method of production. See MPEP 2113.

8. Regarding claim 2, Thurmond further discloses that the two half shells are provided with complementary internal and external walls, contributing to their assembly.

9. Regarding claim 3, Thurmond further discloses that, as best understood by the Examiner, that the upper half shell comprises of a sleeve (62) with a central opening around the median axis, wherein a cylindrical wall (16) projects outwards on a planar wall (82) of the upper half-shell and is extended by an inner cylindrical wall (see above) below said planar wall to connect with a corresponding lower cylindrical wall (74) on the lower half shell, the planar wall (82) of the upper half shell being connected on its periphery to a vertical cylindrical wall (see annotated Fig. 1 of Thurmond) via element 62, connecting it to the lower half-shell.

10. Regarding claims 4 and 24, Thurmond further discloses that the lower half shell comprises of a lower cylindrical inner wall (75) around its median axis corresponding to that of the sleeve of the upper half shell and providing the transverse passage, that the lower cylindrical inner wall is provided with an internal projection (65), that the lower cylindrical inner wall is provided with a projecting peripheral rim (see above) cooperating with the orthogonal peripheral wall of the upper half shell (see annotated Fig. 1 of Thurmond).

11. Regarding claims 5 and 25, Thurmond further discloses that an internal projection (65) is placed between the lower cylindrical inner wall (75) and the peripheral rim. Regarding claims 6 and 26, Thurmond further discloses that the internal projection (65) is of a lesser height than the distance between the planar wall of the upper half-shell and an opposite planar wall of the lower half-shell.

12. Regarding claims 7 and 27, Thurmond further discloses that the lower cylindrical wall (74) of the lower half shell has a conical form with an upper shoulder enabling the tip of the punch of a male panel tag to be locked in.

13. Regarding claims 10, 20, 23 and 29, Thurmond discloses, as best understood by the examiner, a transponder fixed into position. As for the use of an adhesive, see above rejection regarding the method of assembly or forming of a device, MPEP 2113.

14. Regarding claim 12, Thurmond further discloses that the lower half-shell is provide with a peripheral rim which on assembly fits into the external shoulder of the vertical wall of the upper half shell.

15. Regarding claim 14, Thurmond further discloses that the cylindrical wall (74) of the first shell portion provides a passage for a punch of a male tag, wherein said cylindrical wall of the first shell portion having a conical form and providing a shoulder (73) within the sleeve to enable a top of the punch of male tag to be locked in the sleeve.

16. Regarding claim 15, Thurmond further discloses an internal projection (see annotated Fig. 1 of Thurmond) that is located between the cylindrical wall (16) and a peripheral rim (rim of the orthogonal peripheral wall) of the second shell portion, the internal projection being of a height less than the distance between the planar walls of the first and second shell portions.

17. Regarding claim 31, Thurmond further discloses that the two half-shells have substantially a same radius about a median axis.

***Allowable Subject Matter***

18. Claims 8, 9, 11, 17-19, 21, 22, 28, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

19. Applicant's arguments have been fully considered but they are not persuasive. The current examiner has maintained the previous examiner's rejection of the claims, and added additional case law and/or MPEP citations in support thereof.

20. Regarding claim 1, the applicant argues the following:

21. "For this reason, claim 1 has been amended to more clearly define that the device is directed to "An animal tagging and identification electronic button tag", which the device described in Thurmond clearly is not, as it is used to prevent theft of retail items."

22. "Further, a limitation has been included that "the transponder is arranged to uniquely identify an animal in a group of animals". The device in Thurmond is not able to uniquely identify an animal in a group of animals but merely emits an audible signal upon its disassembly. Such an audible signal would not enable the unique identification of an animal in a herd, especially if the device has been removed from the animal in order to activate the audible signal."

23. "Applicant further disagrees with the examiner's assertion that the device in Thurmond includes a programmable transponder merely because it has a switch that triggers a transponder. The transponder in Thurmond merely operates according to the switch condition, and is not programmable to operate in any other way i.e. it operates in a single fixed state and that fixed state is not programmable."

24. Regarding paragraph 21 above, and as previously discussed, the applicant is reminded where there is physical identity between the subject matter of the claims and the prior art, the label given to the claimed subject matter does not distinguish the invention over the prior art. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Lemin, 326 F.2d 437, 140 USPQ 273 (CCPA 1964). Moreover, since Thurmond discloses all of the claimed structure

of the applicant's tag, then the tag can be viewed and labeled as "animal tagging and identification electronic button tag".

25. Regarding paragraph 22 above, the limitation of "arranged to uniquely identify an animal in a group of animals" represents the intended use of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. If the Thurmond button was attached to an animal in a group of animals, it would be capable of uniquely identifying that animal in the group of animals upon disassembly of the tag while attached to the animal.

26. Regarding paragraph 23 above, the transponder is claimed as "capable of being programmed". Thus, the transponder is not claimed as being programmed. In any event, and as the previous examiner stated, the applicant argues that the cited prior art "does not disclose or suggest a programmable transponder enclosed in a shell." Examiner respectfully disagrees. Programmable is defined by Merriam-Webster Online Dictionary as "to provide with a program." The cited prior art states (col.2, lines 20-30) that the transponder is "coupled to the switch for responding to an irradiated interrogation signal by radiating an alarm signal when the switch changes state in response to application to the two components of at least said predetermined threshold separation force." (Emphasis added). Thus, the transponder is provided with a program by the switch; hence said transponder is programmable.



27. The applicant makes similar arguments regarding claims 13 and 23. Regarding the transponder being programmable, the applicant further argues the following:

28. "In Applicant's specification, it is noted that the transponder comprises a coil and programmable microprocessor. Although the limitations from the specification are not read into the claims, Applicant submits that a person skilled in the art would recognize that a programmable transponder is one which includes a microprocessor or equivalent element which can be programmed. The transponder of Thurmond et al. contains no teaching or suggestions whatsoever regarding its programmability."

29. Regarding paragraph 28 above, the examiner reiterates the transponder is claimed as "capable of being programmed". Thus, the transponder is not claimed as being programmed. Although Thurmond fails to disclose a microprocessor, it is noted a microprocessor is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is (571) 272-7068. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William L. Miller/  
Primary Examiner, Art Unit 3677